

recited limitation of the amendment was inherent in original claim 8. In particular, original claim 8 already recited “a layer from ... the ejected MgB₂”. Also, Applicants stated that original claim 8 recites a “layer of MgB₂” at page 2 of the previous Response, which was filed on Nov. 6, 2002. Second, Applicants only became aware of a need to explicitly recite such a limitation from the present Office Action. At page 5, the present Office Action states that claim 8 does not require “that the film being deposited is MgB₂”. Finally, the amendment is being made to place the claims in condition for allowance. In particular, the Examiner has indicated that reference Satou does not seem to disclose growing a MgB₂ layer. See Interview Summary, dated March 19, 2003.

Rejection under 35 U.S.C. § 102

The Office Action rejects claims 8, 9, 13, 14 as anticipated by U.S. Patent 4,657,774 (“Satou”). At page 5, the Office action further states that:

Applicant argues that Satou fails to teach growing a layer of MgBr₂ as is allegedly claimed in claim 8. This argument is unpersuasive. Applicant’s claim 8 only reads to form a layer on the substrate from ejected MgBr₂. There is no limitation requiring that the film being deposited is MgBr₂.

Applicants have amended claim 8 to explicitly recite that the growing step produces an MgB₂ layer. Even if Satou uses evaporation sources that include boron and magnesium, Satou does not disclose producing an MgB₂ layer. Furthermore, it is not inherent that Satou’s methods to produce MgB₂ layers. For these reasons, Satou does not anticipate claim 8 as now amended.

Dependent claims 9, 13, and 14 are novel, at least, by their dependence on novel amended claim 8.

Rejections under 35 U.S.C. § 103

The Office Action also rejects claims 10 – 12, and 15 as obvious over various art.

Claims 10-12, and 15 are non-obvious, at least, by their dependence on non-obvious amended claim 8.

Applicants respectfully request allowance of claims 8-15 as presently amended.

No fee is believed necessary. In the event of any non-payment or improper payment of a required fee, the Commissioner is authorized to charge or to credit **Lucent Technologies Deposit Account No. 12-2325** to correct the error.

Respectfully,



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MARKED UP CLAIM AMENDMENTS

8. (first amended) A process for making a structure, comprising:
providing a solid body of MgB_2 ;
ejecting MgB_2 from the body by directing laser light onto the body; and
growing an MgB_2 layer on a surface of a substrate from a portion of the ejected
 MgB_2 .